

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of)	
Trademark Registration No. 2,772,766)	
For the Mark SAN DIMAS GUITARS THE)	
CALIFORNIA GUITAR COMPANY (Design))	
Registration Date: October 7, 2003)	
)	
JACKSON/CHARVEL MANUFACTURING,)	Cancellation No. 92042614
INC.,)	
Petitioner,)	
)	
v.)	
)	
PRINS, LLOYD A.,)	
Registrant-Respondent.)	

**PETITIONER'S RESPONSE IN OPPOSITION TO
REGISTRANT'S MOTION TO COMPEL**

Petitioner Jackson/Charvel Manufacturing, Inc. ("Jackson/Charvel"), by its undersigned attorneys and pursuant to Rule 37 of the Federal Rules of Civil Procedure, hereby responds in opposition to Respondent Lloyd A. Prins' ("Prins") Motion to Compel (the "Motion").

I. RESPONDENT FAILED TO CERTIFY GOOD FAITH EFFORT TO RESOLVE DISCOVERY DISPUTE

When filing a motion to compel, the moving party must provide "a written statement . . . that such party . . . has made a good faith effort . . . to resolve with the other party or the attorney therefore the issues presented in the motion and has been unable to reach agreement." 37 CFR § 2.120(e); *see also* Trademark Trial and Appeal Board Manual of Procedure ("TBMP") § 523.02, at 500-82 (2d ed., 1st rev. 2004). Prins' Motion to Compel does not make such a certification. Indeed, Prins Motion appears to indicate that he filed his Motion to Compel rather than engage in good faith negotiation concerning the discovery dispute.

Jackson/Charvel attaches as Exhibit 1 hereto the Declaration of Salvador K. Karottki, its counsel, describing the interactions between Prins and counsel for Jackson/Charvel. Rather than discuss the discovery dispute with opposing counsel, Prins stated that he was too busy to engage in Rule 37 negotiations, stating that he did not have time to make a telephone call to Jackson/Charvel's counsel on December 6th or 7th. (See Declaration of Salvador K. Karottki [hereinafter "Karottki Decl."], attached hereto as Exhibit 1, at ¶ 15.) However, while Prins was too busy to call opposing counsel, he had time to draft and file a Motion to Compel with the Trademark Trial and Appeal Board ("TTAB") as a *pro se* respondent.

Based on the foregoing, Jackson/Charvel submits that Prins could not make the requisite certification of good faith negotiation; therefore, he did not. Because the Motion does not contain a written statement by Prins that he made a good faith effort to resolve this discovery dispute, the Motion should be denied, without prejudice to re-file if the parties have not informally resolved the dispute.

II. RESPONDENT REQUESTS OVERBROAD DISCOVERY RELATING TO MARKS NOT AT ISSUE AND EVIDENCE TO BE OFFERED AT TRIAL

In response to a letter from Prins dated November 13, 2004, counsel for Jackson/Charvel sent a detailed letter, enumerating the areas where Prins' arguments have no merit. (See Exhibit G to Karottki Decl.) Prins' Motion contains similar,¹ if not identical arguments to his November 13th letter; therefore, Jackson/Charvel hereby incorporates its response letter, a copy of which is attached hereto as Exhibit G to Exhibit 1, as its response to Prins' Motion.

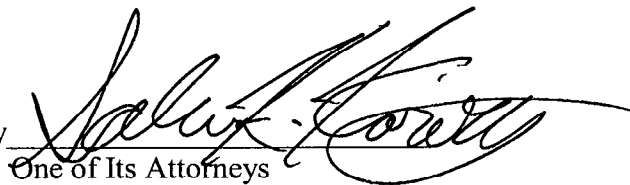
¹ Prins' letter of November 13th does not address Interrogatory No. 7. As with many of Prins' discovery requests, Interrogatory 7 improperly requests evidence which Jackson/Charvel intends to offer at trial. See, e.g., *Polaroid Corp. v. Opto Specs, Ltd.*, 181 U.S.P.Q. 542, 543 (T.T.A.B. 1974) ("[I]t has been frequently held that a party may not be required, by way of interrogatory, to specify in detail prior to trial the evidence which it expects to present in support of its case."), *overruled on other grounds by Johnson & Johnson v. Rexall Drug Co.*, 186 U.S.P.Q. 167 (T.T.A.B. 1975).

December 27, 2004

Respectfully Submitted,

JACKSON/CHARVEL MANUFACTURING,
INC.

By



One of Its Attorneys

Oscar L. Alcantara
Salvador K. Karottki
GOLDBERG, KOHN, BELL, BLACK,
ROSENBLOOM & MORITZ, LTD.
55 East Monroe Street, Suite 3700
Chicago, Illinois 60603
(312) 201-4000

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of)	
Trademark Registration No. 2,772,766)	
For the Mark SAN DIMAS GUITARS THE)	
CALIFORNIA GUITAR COMPANY (Design))	
Registration Date: October 7, 2003)	
)	
JACKSON/CHARVEL MANUFACTURING,)	Cancellation No. 92042614
INC.,)	
Petitioner,)	
)	
v.)	
)	
PRINS, LLOYD A.,)	
Registrant-Respondent.)	

DECLARATION OF SALVADOR K. KAROTTKI

Salvador K. Karottki, Esq., pursuant to 28 U.S.C. Section 1746, declares as follows:

1. My name is Salvador K. Karottki, Esq., and I have personal knowledge of the matters set forth in this Declaration and could and would testify competently thereto if called as a witness.

2. I am attorney licensed to practice law in the State of Illinois. I practice with the law firm of Goldberg, Kohn, Bell, Black, Rosenbloom & Moritz, Ltd., located in Chicago, Illinois. I am Attorney of Record in the above-captioned Cancellation Proceeding, representing Jackson/Charvel Manufacturing, Inc. ("Jackson/Charvel").

3. On October 28, 2004, and on behalf of Jackson/Charvel, I timely served answers and objections to Respondent Lloyd A. Prins' ("Prins") First Set of Interrogatories (the "Interrogatory Requests"). A true and correct copy of Jackson/Charvel's Answers to Respondent's First Set of Interrogatories is attached hereto as Exhibit A. That same day, I also

served objections and produced documents to Prins in response to his First Set of Requests for Production of Documents.

4. On Monday, November 15, 2004, I received via Express Mail a letter from Prins taking issue with every one of Jackson/Charvel's answers to Prins' Interrogatory Requests, except the answer to Interrogatory No. 7. Prins' letter was dated November 13, 2004. A true and correct copy of Prins' letter of November 13, 2004, is attached hereto as Exhibit B. Prins' letter stated, "[P]lease find enclosed a protective order for your client's signature." (Ex. B at 1.) No protective order was enclosed. Prins letter also requested a response to his 7-page letter by November 19, 2004—four days after it had been received by our office.

5. On that same Monday, I also reviewed an e-mail message from Prins, which had been sent on Saturday, November 13, 2004, at 2:05 p.m. Prins had e-mailed me the letter two days prior. A true and correct copy of Prins' e-mail from November 13, 2004, is attached hereto as Exhibit C. Despite the fact that Prins had taken approximately two weeks to send me the letter, his e-mail stated that his "request [was] time sensitive." (Ex. C.)

6. On Wednesday, November 17, 2004, I received a letter from Prins dated November 16, 2004, attaching what appeared to be a form Protective Order from the U.S. Patent and Trademark website. A true and correct copy of Prins' letter of November 16, 2004, is attached hereto as Exhibit D.

7. On that same day, November 17, I e-mailed Prins, confirming receipt of his draft Protective Order and letter dated November 13, 2004. A true and correct copy of my e-mail to Prins on November 17 is attached hereto as Exhibit E. In my e-mail, I stated that we would respond in writing to his letter of November 13 and that I had not yet reviewed his draft Protective Order, which I had just received. (*See* Ex. E.)

8. In his Motion to Compel, Prins states, "Neither Petitioner nor Petitioner's counsel acknowledged receipt of this request [Prins' letter of November 13] until after three days beyond the period in which Registrant requested a reply [on Friday, November 19.]" (Motion to Compel at 2.) This is not true. As Exhibit E clearly evidences, I acknowledged receipt of the draft Protective Order on the day it was received and acknowledged Prins' letter of November 13 within two days of receipt. I also informed Prins in my e-mail that he should feel free to call me to discuss the issues in his letter of November 13, 2004. (*See Ex. E.*)

9. On Tuesday, November 23, 2004, I telephoned Prins to let him know that I would not be able to get back to him that week. Thanksgiving was on that Thursday, November 25, and Jackson/Charvel's client contact was not in the office that week. My primary reason for calling Prins was to let him know that I could not respond to his letter at that time. I clearly stated to Mr. Prins that I would either (1) respond in writing to his letter of November 13 by December 3, 2004, or (2) I would contact him and tell him when a response would be forthcoming. I repeated this several times to Prins. I was clear to indicate that I might not respond by December 3 but may call with a response date instead, because I knew I could not guarantee whether my client contact would get back to me in time to draft a response to a lengthy, 7-page letter. I did not request a two-week extension, and Prins never indicated that he was granting me a two-week extension. Prins never stated that he was "extend[ing] a deadline," as he states in his Motion to Compel. (Motion to Compel at 2.) Neither Prins nor I mentioned a deadline of Friday, November 3, on which Jackson/Charvel must respond.

10. While I was able to obtain some information to assist in responding to Prins letter of November 13, I was not in a position to draft a response letter by Friday, December 3. Furthermore, I had reviewed the draft Protective Order and had several changes that I wanted to "pass by" Prins to see if he agreed to them in concept before I made the changes.

11. I telephoned Prins three times on Friday, December 3, 2004. The first time someone answered and stated that Prins was not there. To ensure that I did not have a wrong telephone number, I called Prins back later two more times using the number (909) 241-7997, which had been the number at which I had reached Prins previously. The telephone rang multiple times and no answering machine picked up.

12. On Monday, December 6, 2004, I e-mailed Prins, stating that I was not able to reach him during the last week and that he should call me on Monday or Tuesday of that week. A true and correct copy of my e-mail of December 6, 2004, to Prins is attached hereto as Exhibit F. My e-mail to Prins stated, "I called you a couple of times last week at 909-241-7997 and was unable to reach you. *Please give me a call today or tomorrow* to discuss the Protective Order, as I would like to put this issue to bed so we can send you additional documents. Furthermore, we will get you additional information, as well as specific responses to your objections, this week." (Ex. F. (emphasis added).)

13. Prins did not call me on Monday or Tuesday as requested.

14. Instead of calling me back, Prins filed a Motion to Compel on Tuesday, December 7, with the Trademark Trial and Appeal Board ("TTAB"). I did not receive Prins' Motion to Compel until Friday, December 10.

15. On Friday, December 10, 2004, I called Prins to discuss why he had filed a Motion to Compel, instead of working with me to resolve the discovery dispute pursuant to rule 37 of the Rules of Civil Procedure. I informed Prins that I was disappointed that this was "the road he had chosen to go down," filing motions with the TTAB instead of working together as parties are obligated to do under the Rules. I reminded Prins that I had sent him an e-mail on Monday, requesting that he call me to discuss the draft Protective Order and his letter of November 13 and asked him why he did not call me. Prins stated that he was too busy at this

time of the year to call me to discuss the matter. I told him, *inter alia*, that I regretted having to waste my client's resources, as well as the TTAB's time and resources, with his Motion to Compel.

16. Since the filing of Prins' Motion to Compel, I have sent a draft Confidentiality Stipulation and Protective Order to Prins. I also just sent a response to Prins' Rule 37 letter, stating that Jackson/Charvel would supplement certain discovery responses but that certain requests by Prins are improper. A true and correct copy of my response letter to Prins is attached hereto as Exhibit G.

17. I declare under penalty of perjury that the foregoing is true and correct.

Executed on December 27, 2004.



SALVADOR K. KAROTTKI

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of)	
Trademark Registration No. 2,772,766)	
For the Mark SAN DIMAS GUITARS THE)	
CALIFORNIA GUITAR COMPANY (Design))	
Registration Date: October 7, 2003)	
)	
JACKSON/CHARVEL MANUFACTURING,)	Cancellation No. 92042614
INC.,)	
Petitioner,)	
)	
v.)	
)	
PRINS, LLOYD A.,)	
Registrant-Respondent.)	

**PETITIONER'S ANSWERS TO RESPONDENT'S FIRST SET OF
INTERROGATORIES**

Petitioner Jackson/Charvel Manufacturing, Inc. ("Jackson/Charvel"), by its undersigned attorneys and pursuant to Rule 33 of the Federal Rules of Civil Procedure and Trademark Rule 2.119(c), hereby answers Respondent Lloyd A. Prins' ("Prins") First Set of Interrogatories as follows:

GENERAL RESPONSES AND OBJECTIONS

A. Jackson/Charvel objects to Prins' Interrogatories, including any instructions and definitions (herein collectively referred to as the "Interrogatories"), to the extent that they impose upon it discovery obligations beyond the scope allowed under the Federal Rules of Civil Procedure and the Rules of Practice and Procedure before the Trademark Trial and Appeal Board.

B. Jackson/Charvel objects to Prins' Interrogatories to the extent that they require disclosure of information subject to the work product immunity, the attorney-client privilege, and/or any other applicable privilege or doctrine.

C. Jackson/Charvel objects to Prins' Interrogatories to the extent that they seek competitively sensitive information or information of a confidential nature, including but not limited to customer information. To the extent that confidential information is sought, Jackson/Charvel may, subject to its other objections, provide such information but only upon entry of and pursuant to an appropriate Confidentiality Agreement and Protective Order.

D. Jackson/Charvel objects to Prins' Interrogatories to the extent that they seek personal information, such as their home addresses, of current employees of Jackson/Charvel or personal information, such as social security numbers and dates of birth, of former employees of Jackson/Charvel or its predecessors-in-interest.

E. Jackson/Charvel objects to Prins' Interrogatories to the extent that they are overly broad and/or unduly burdensome.

F. Jackson/Charvel objects to Prins' Interrogatories to the extent that they are vague, ambiguous and/or otherwise incapable of reasonable ascertainment.

G. Jackson/Charvel objects to the term "Petitioner" or "Petitioner's" as used in Prins' Interrogatories as vague, ambiguous, and undefined. Any answer to Prins' Interrogatories provided by Jackson/Charvel specifically incorporates Jackson/Charvel's predecessors-in-interest, including Akai Musical Instruments Corporation ("Akai") and International Music Company ("IMC"), ("Predecessors-in-Interest") in the definitions of the terms "Petitioner" and "Petitioner's." It should be understood that Jackson/Charvel's answers to Prins' Interrogatories, wherein the terms "Petitioner" or "Petitioner's" were used, that employ the term "Jackson/Charvel" also include Jackson/Charvel's Predecessors-in-Interest.

H. Jackson/Charvel objects to Prins' Interrogatories to the extent that they seek information that is irrelevant and/or not reasonably calculated to lead to the discovery of admissible evidence.

I. Jackson/Charvel objects to Prins' Interrogatories to the extent that they seek information that can be obtained from other sources that are more convenient, less burdensome, and/or less expensive.

J. Jackson/Charvel objects to Prins' Interrogatories to the extent that they assume facts not in evidence.

K. Jackson/Charvel expressly reserves its right to supplement its answers.

L. Jackson/Charvel's answers to the Interrogatories are based on information available to Jackson/Charvel at the time, and Jackson/Charvel reserves the right to revise, correct, supplement, or clarify its objections and responses given subsequently identified information.

M. Jackson/Charvel objects to Prins' Interrogatories to the extent that they request that Jackson/Charvel describe, list, or characterize documents otherwise requested pursuant to Rule 34 of the Federal Rules of Civil Procedure. The documents speak for themselves. Requests for written descriptions of documents are unduly burdensome to Jackson/Charvel, and the burden of deriving or ascertaining the answer to such Interrogatories is substantially the same for Prins as Jackson/Charvel.

N. Jackson/Charvel objects to Prins' Interrogatories to the extent that they request the attachment of documents. Jackson/Charvel has contemporaneously responded to Document Requests served by Prins and objects to any additional requirement for identifying or attaching documents to these Interrogatories as unduly burdensome.

O. Pursuant to Rule 33 (d) of the Federal Rules of Civil Procedure, Jackson/Charvel specifically reserves the right to answer any Interrogatories by producing certain documents or business records when the answers to Interrogatories can be adduced by reviewing such documents or business records and the burden of deriving or ascertaining the

answers to Interrogatories from such documents or business records is substantially the same for Prins as for Jackson/Charvel.

P. Jackson/Charvel does not waive any of its objections by providing any of the following answers, but instead expressly answers subject to those objections.

INDIVIDUAL RESPONSES AND OBJECTIONS

Subject to and without waiving the foregoing General Responses and Objections, Jackson/Charvel responds to the Interrogatories as follows:

1. Identify each and every person, company, or entity that may offer expert testimony in the above captioned proceeding and state after each person:
 - A. His/her qualifications and current curriculum;
 - B. The subject matter on which the expert may be called to testify;
 - C. The substance of the facts and opinions to which the expert may be called to testify;
 - D. A summary of the grounds for each opinion; and

ANSWER: Jackson/Charvel incorporates by reference its General Responses and Objections.

Without waiving its General Responses and Objections, Jackson/Charvel answers that it has not yet determined whether it will offer expert testimony in the above-captioned proceeding.

Jackson/Charvel will seasonably update its Interrogatory answer pursuant to Rule 26(e) of the Federal Rules of Civil Procedure if and when it makes such a determination.

2. Identify each and every person who may offer factual testimony in the above captioned proceeding and state after each person the subject and/or subjects which he/she may be called to testify.

ANSWER: Jackson/Charvel incorporates by reference its General Responses and Objections. Jackson/Charvel specifically objects that this Interrogatory is overly broad. Without waiving its specific objections or its General Responses and Objections,

Jackson/Charvel answers that the following employees may offer testimony on the use of the SAN DIMAS trademark by Jackson/Charvel or its Predecessors-in-Interest, the association of Jackson/Charvel as the source of origin for goods marketed in conjunction or connection with the SAN DIMAS trademark, and the secondary meaning achieved by Jackson/Charvel's SAN DIMAS trademark among consumers and the industry:

Donnie Wade
Tim Wilson
Mike Shannon
Manny Ledesma
Greg Burnett
Carlos Leone
Alberto Robles
Juan Antonio Gonzalez
Juan Pablo Santana
Felipe Muro Fonseca
Edel Diaz
John Walker
Jeff Cary
Richard McDonald
Brian McDonald
Andy Rossi
Mark Van Vleet

The foregoing individuals are employed by Jackson/Charvel or Fender Musical Instruments Corporation and may be contacted through undersigned counsel.

Jackson/Charvel answers further that the following individuals or entities may offer testimony on the use of the SAN DIMAS trademark by Jackson/Charvel or its Predecessors-in-Interest, the association of Jackson/Charvel as the source of origin for goods marketed in conjunction or connection with the SAN DIMAS trademark, and the secondary meaning achieved by Jackson/Charvel's SAN DIMAS trademark among consumers and the industry:

Steve Blucher
Steve Kaufman
Bret Dennis
Todd Taliaforo

Mike Johnson

Tommy Moore

Any customers purchasing SAN DIMAS brand guitars from Jackson/Charvel or its Predecessors-in-Interest identified on customer lists or sales invoices

The foregoing individuals are not currently employed by Jackson/Charvel or Fender Musical Instruments Corporation. Investigation continues concerning the current addresses of these individuals.

3. Identify each and every person whom Petitioner claims to have knowledge of the facts and claims as set forth in its Petition to Cancel. For each person, the answer should include what knowledge it is Petitioner claims each person has.

ANSWER: Jackson/Charvel incorporates by reference its General Responses and Objections.

Jackson/Charvel specifically objects that this Interrogatory is overly broad. Without waiving Jackson/Charvel's specific objections or its General Responses and Objections, see answer to Interrogatory No. 2.

4. Identify each and every document and tangible thing that Petitioner claims support the facts and claims set forth in its Petition to Cancel.

ANSWER: Jackson/Charvel incorporates by reference its General Responses and Objections.

Jackson/Charvel specifically objects that this Interrogatory is overly broad and unduly burdensome.

5. Set forth in detail any efforts undertaken by Petitioner or any of its employees, or by any vendor, person, company or entity acting for the Petitioner, for the purpose of obtaining information concerning the Registrant's activities related to the San Dimas mark.

ANSWER: Jackson/Charvel incorporates by reference its General Responses and Objections.

Jackson/Charvel specifically objects that this Interrogatory is irrelevant and not reasonably calculated to lead to the discovery of admissible evidence. Jackson/Charvel further objects that the phrase "Registrant's activities related to the San Dimas mark" is vague, ambiguous, and

undefined. Without waiving its specific objections or its General Responses and Objections, Jackson/Charvel answers that its employees or agents reviewed Prins' website, as well as communications by and/or correspondence from Prins regarding his use of the SAN DIMAS mark. Jackson/Charvel's in-house counsel, Mark Van Vleet, also sent Prins correspondence concerning his infringing use of the SAN DIMAS mark without authorization from Jackson/Charvel.

6. Set forth in narrative form any investigations, internal or otherwise, conducted by Petitioner, where the Registrant was either directly or indirectly the focus of such investigation(s).
 - A) State what type of investigation was conducted including dates, times and places;
 - B) Identify any person who participated in such investigations and/or interviews and indicate whether the person was the interviewer, interviewee, observer or served any other role;
 - C) Identify all documents that were generated in the course of such investigation. Include hand-written notes, minutes, follow-up memos, and employee discipline reports; and
 - D) Summarize the findings of such investigation.

ANSWER: Jackson/Charvel incorporates by reference its General Responses and Objections.

Jackson/Charvel specifically objects that the term "investigations" is vague and undefined.

Jackson/Charvel further objects that this Interrogatory is irrelevant and not reasonably calculated to lead to the discovery of admissible evidence to the extent it concerns anything other than

Prins' unauthorized use of the SAN DIMAS trademark. In addition, Jackson/Charvel objects to this Interrogatory to the extent it seeks information covered by the attorney-client or attorney work product privileges. Without waiving Jackson/Charvel's specific objections or its General Responses and Objections, see answer to Interrogatory No. 5. Jackson/Charvel further answers

that, in investigating Prins' unauthorized use of the SAN DIMAS trademark, its in-house counsel, Mark Van Vleet, sent letters to Prins. These letters are in Prins' possession.

7. Set forth in narrative form, any and all documentary evidence, photographs or testimony Petitioner intends to rely on that disputes the accuracy or facts of Registrants claim to the use of the San Dimas trademark.

ANSWER: Jackson/Charvel incorporates by reference its General Responses and Objections. Jackson/Charvel specifically objects that this Interrogatory is overly broad and unduly burdensome. Jackson/Charvel further objects to "setting forth in narrative form" "documentary evidence" or "photographs" as nonsensical and unduly burdensome. In addition, "the accuracy or facts of Registrants [sic] claim to the use of the San Dimas trademark" is undefined, and any such "claim" does not appear in any pleadings in this proceedings. Therefore, Jackson/Charvel is not required to offer testimony to "dispute" any such "claim." Without waiving Jackson/Charvel's specific objections or its General Responses and Objections, Jackson/Charvel will offer testimony to support the allegations in its Petition for Cancellation, the allegations of which are clearly contain in such Petition. Answering further, see answer to Interrogatory No. 2.

8. Completely list and describe all documents and other tangible things (including but not limited to tapes, photographs, diaries, logs, schedules, data files, etc) that Petitioner intends to use in the preparation the above referenced proceeding.

ANSWER: Jackson/Charvel incorporates by reference its General Responses and Objections. Jackson/Charvel specifically objects that this Interrogatory is overly broad and unduly burdensome.

9. Set forth in narrative form the facts and circumstances relate to the Petitioner's purchase of the Jackson/Charvel Division from Akai Musical Instruments Corporation. Include the purchase price, the date of purchase, a complete list of all assets purchased, all trademarks purchased and the value of good will included in the purchase.

ANSWER: Jackson/Charvel incorporates by reference its General Responses and Objections.

Jackson/Charvel specifically objects that this Interrogatory is overly broad, irrelevant, and not reasonably calculated to lead to the discovery of admissible evidence to the extent it concerns anything other than the purchase of the SAN DIMAS trademark. Jackson/Charvel further objects that this Interrogatory requests confidential information. Without waiving Jackson/Charvel's specific objections or its General Responses and Objections, Jackson/Charvel answers that on October 25, 2002, Jackson/Charvel purchased specific assets of the Jackson/Charvel Division of Akai, which included, among other things, rights to the SAN DIMAS trademark.

10. Set forth in detail all trademarks, registered or unregistered, for which the Petitioner claims ownership. For registered trademarks provide registration. For non-registered marks, provide a description of mark, date of first use, the geographic locations where product(s) is/was sold using the non-registered mark, and date of last use.

ANSWER: Jackson/Charvel incorporates by reference its General Responses and Objections.

Jackson/Charvel specifically objects that this Interrogatory is overly broad, irrelevant, and not reasonably calculated to lead to the discovery of admissible evidence to the extent it concerns anything other than Jackson/Charvel's SAN DIMAS trademark. Jackson/Charvel further objects that this Interrogatory assumes facts not in evidence, in that it assumes a "date of last use." Without waiving Jackson/Charvel's specific objections or its General Responses and Objections, see answer to Interrogatory No. 12. Answering further, Jackson/Charvel states that it is selling

and has sold SAN DIMAS brand guitars in interstate commerce throughout the United States and in foreign countries. Jackson/Charvel continues to use the trademark SAN DIMAS.

11. Set forth in narrative form the facts and circumstances related to all trademark for which the Petitioner is not currently using but plans to use in the future. Identify all persons who have knowledge of such plans and Identify all documents and tangible things that support this answer.

ANSWER: Jackson/Charvel incorporates by reference its General Responses and Objections. Jackson/Charvel specifically objects that this Interrogatory is overly broad, unduly burdensome, irrelevant, and not reasonably calculated to lead to the discovery of admissible evidence.

12. Set forth in detail the facts and circumstances that resulted in Petitioner's first use of the San Dimas mark. Include in the answer:
- A) The date of first use of the San Dimas trademark;
 - B) The physical address of each manufacturing plant where San Dimas trademarked products were produced;
 - C) A specimen of the San Dimas mark and how it was used in association with the sale of product;
 - D) A listing of all employees (present and past) who were involved in the design, manufacturing, marketing and selling;
 - E) Each product's serial numbers;
 - F) Each product's date of manufacturing;
 - G) Each product's work order or production control number;
 - H) The geographic location where San Dimas trademarked items were sold; and
 - I) Any and all persons credited with originating the San Dimas trademark concept.

ANSWER: Jackson/Charvel incorporates by reference its General Responses and Objections. Jackson/Charvel specifically objects that this Interrogatory is overly broad and unduly burdensome to the extent it requests "a listing of all employees (past and present) who were involved in the design, manufacturing, marketing and selling" of SAN DIMAS brand guitars. Jackson/Charvel further objects that this Interrogatory is overly broad and unduly burdensome to the extent it requests (i) "[e]ach product's serial numbers;" (ii) "[e]ach product's date of manufacturing;" and (iii) and "[e]ach product's work order or production control number." In addition, Jackson/Charvel objects to this Interrogatory to the extent it requests inclusion of "[a] specimen of the San Dimas mark." (Examples of the SAN DIMAS trademark are included in documents produced in response to Prins' Document Requests.) Furthermore, Jackson/Charvel objects that the phrase "credited with originating the San Dimas trademark concept" is vague, ambiguous, and undefined.

Without waiving Jackson/Charvel's specific objections or its General Responses and Objections, the first use of Jackson/Charvel's SAN DIMAS trademark was on or about June 22, 1993. Answering further, Jackson/Charvel states that the physical addresses where SAN DIMAS brand products were and/or are produced are: (i) 4452 E. Airpark Drive, Ontario, California, 91761 and (ii) 311 Cessna Cir., Corona, California, 92880. Current or former Jackson/Charvel employees involved in the production of SAN DIMAS brand products were and/or are: Tommy Moore, Tommy Moore II, Todd Taliafaro, Mike Johnson, Steve Kaufman, and Tim Wilson. (See also answer to Interrogatory No. 2.) Jackson/Charvel marketed, sold, and continues to market and sell SAN DIMAS brand guitars in interstate commerce throughout the United States and in foreign countries. Jackson/Charvel used and/or continues to use its SAN DIMAS mark, *inter alia*, in advertising for its products, in catalogs, on materials associated with

the products, and on point-of-sale displays for its products. In addition, both Jackson/Charvel sales staff and customers use the SAN DIMAS trademark as a source identifier for its products.

13. Set forth in detail the method by which Petitioner used the San Dimas mark to distinguish products sold under this mark from Petitioner's non-San Dimas products. Limit answer to products manufactured prior to October 2002.

ANSWER: Jackson/Charvel incorporates by reference its General Responses and Objections. Jackson/Charvel specifically objects that this Interrogatory vague and ambiguous. Without waiving its specific objections or its General Responses and Objections, Jackson/Charvel states that it used the SAN DIMAS trademark in both word and logo form in connection with the marketing and sale of certain Jackson/Charvel products. For ways in which the SAN DIMAS trademark was used, see answer for Interrogatory No. 12. The use of the SAN DIMAS trademark in connection with certain products and not others itself could be said to distinguish the different Jackson/Charvel products. However, Jackson/Charvel's use of the SAN DIMAS trademark was as an indicator of source for Jackson/Charvel, therefore acting as a way for consumers to distinguish Jackson/Charvel products from those of *other companies*, not necessarily as a way to distinguish between different Jackson/Charvel products. Jackson/Charvel's and its customers' use of the SAN DIMAS trademark therefore facilitated inter-brand competition between Jackson/Charvel and other companies by allowing consumers to identify Jackson/Charvel products through association with the SAN DIMAS trademark.

14. Set forth in individual year summaries, the year-end total dollar sales for all Jackson/Charvel guitars and basses for each year 1993 to present.
 - A) For each year's total dollar sales, identify how many total dollars came through the sale of San Dimas trademarked product.

ANSWER: Jackson/Charvel incorporates by reference its General Responses and Objections. Jackson/Charvel specifically objects that this Interrogatory is overly broad, irrelevant, and not

reasonably calculated to lead to the discovery of admissible evidence to the extent it concerns anything other than SAN DIMAS brand products. Jackson/Charvel further objects that this Interrogatory seeks confidential information. Jackson/Charvel may, subject to its other objections, provide such information but only upon entry of and pursuant to an appropriate Confidentiality Agreement and Protective Order.

15. Set forth in individual year summaries, the year-end total number of Jackson/Charvel guitars and basses sold for each year 1993 to present.

A) For each year's total number identify how many total dollars came through the sale of San Dimas trademarked product.

ANSWER: Jackson/Charvel incorporates by reference its General Responses and Objections. Jackson/Charvel specifically objects that this Interrogatory is overly broad, irrelevant, and not reasonably calculated to lead to the discovery of admissible evidence to the extent it concerns anything other than SAN DIMAS brand products. Jackson/Charvel further objects that this Interrogatory seeks confidential information. Jackson/Charvel may, subject to its other objections, provide such information but only upon entry of and pursuant to an appropriate Confidentiality Agreement and Protective Order.

16. Set for in specific detail the legal argument on which Petitioner claims ownership and rights to exclusive use of the San Dimas mark.

ANSWER: Jackson/Charvel incorporates by reference its General Responses and Objections. Jackson/Charvel specifically objects that this Interrogatory assumes facts not in evidence; Jackson/Charvel is seeking cancellation of Registration No. 2,772,766. Without waiving its specific objections or its General Responses and Objections, Jackson/Charvel states that its legal theory concerning why Registration No. 2,722,766 should be cancelled is described in its Petition for Cancellation. Under Section 2(d) of the Lanham Act, a mark should not be

registered if it "consists of or comprises a mark which so resembles a . . . mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive" Jackson/Charvel's prior and continuous use of the SAN DIMAS mark, therefore, compels cancellation of Prins' Registration No. 2,722,766.

17. Specific to the Charvel products promoted in a 1995 catalog and again in a 1996 catalog, set forth in detail the facts and circumstances surrounding the introduction and cessation of these products. Include in the answer a description of the specimen trademark; describe how this trademark was used in association with the sale of these products; and state whether these products were replicas of an earlier era product and if not, how they differed.

- A) Identify any and all persons who originated this concept, those who were responsible for its introduction, and those who were responsible for its cessation.

ANSWER: Jackson/Charvel incorporates by reference its General Responses and Objections.

Jackson/Charvel specifically objects that this Interrogatory is overly broad, unduly burdensome, vague, ambiguous, and assumes facts not in evidence (*e.g.*, "cessation"). Jackson/Charvel further objects to the term "specimen trademark" and the phrase "products promoted in a 1995 catalog and again in a 1996 catalog" as vague, ambiguous, and undefined. In addition, Jackson/Charvel objects that the term "this concept" is vague, ambiguous, and undefined. Furthermore, Jackson/Charvel objects that "whether these products were replicas of an earlier era product and if not, how they differed" is irrelevant and not reasonably calculated to lead to the discovery of admissible evidence. Without waiving its specific objections or its General Responses and Objections, Jackson/Charvel states that products in connection with its SAN DIMAS trademark were first conceived and produced in 1993; displayed and sold at, *inter alia*, the NAMM tradeshow in 1994; and advertised in catalogs and sold in 1995 and 1996. After 1996,

Jackson/Charvel continued to sell SAN DIMAS brand products through 2002. In 2003, Jackson/Charvel displayed and sold at the NAMM tradeshow the 25th Anniversary SAN DIMAS brand guitar. See answers to Interrogatory Nos. 12 and 13 concerning use of the SAN DIMAS trademark and answer to Interrogatory No. 12 concerning individuals involved in the introduction of the SAN DIMAS mark. Because Jackson/Charvel has continuously used the SAN DIMAS mark since 1993, there are no individuals involved in the marks "cessation."

18. Set forth in narrative form the facts and circumstances that led to Petitioner's first knowledge of Registrant's use of the San Dimas trademark.

ANSWER: Jackson/Charvel incorporates by reference its General Responses and Objections. Without waiving its General Responses and Objections, Jackson/Charvel discovered Prins' trademark application (Serial No. 78190509) when a Jackson/Charvel employee reviewed the U.S. Patent and Trademark Office website. Upon learning of Prins' application, Jackson/Charvel sent a cease and desist letter to Prins. This letter is in Prins' possession.

19. Set forth in narrative form the facts and circumstances related to the Petitioner's use of the San Dimas trademark commencing with the twenty-fifth anniversary Charvel guitar.

- A) Include the dates and times for all meetings;
- B) Identify all persons who participated in these meetings;
- C) Identify any product prototypes built, where they were built and identify all persons involved in building them; and
- D) Identify the location of the manufacturing plant where any and all products are built.

ANSWER: Jackson/Charvel incorporates by reference its General Responses and Objections. Jackson/Charvel specifically objects that this Interrogatory is overly broad, unduly burdensome,

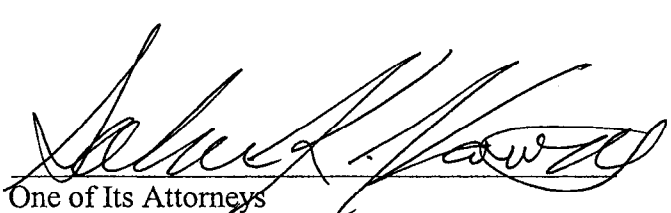
and irrelevant, as the introduction of the 25th Anniversary SAN DIMAS brand guitar occurred after the filing date of Prins' use-based application.

20. Is it Petitioner's response to each request for admission served with these interrogatories an unqualified admission? If not, for each response that is not an unqualified admission:
- A) State the number of the request;
 - B) State the facts on which Petitioner bases its response; and
 - C) State the names, addresses and telephone numbers of all persons who have knowledge of those facts.

ANSWER: Jackson/Charvel incorporates by reference its General Responses and Objections. Jackson/Charvel specifically objects that this Interrogatory is vague, ambiguous, and confusing. Without waiving its specific objections or its General Responses and Objections, Jackson/Charvel's Interrogatory answers are answers pursuant to Rule 33 of the Federal Rules of Civil Procedure; they are not unqualified admissions.

DATED: October 28, 2004

JACKSON/CHARVEL MANUFACTURING, INC.

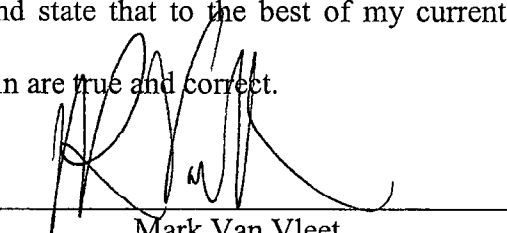
By: 
One of Its Attorneys

Oscar L. Alcantara
Salvador K. Karottki
GOLDBERG, KOHN, BELL, BLACK,
ROSENBLUM & MORITZ, LTD.
55 East Monroe Street, Suite 3700
Chicago, Illinois 60603
(312) 201-4000
Attorneys for Jackson/Charvel Manufacturing, Inc.

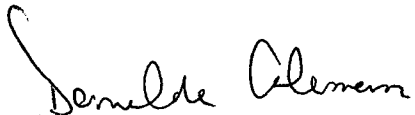
VERIFICATION OF INTERROGATORY ANSWERS

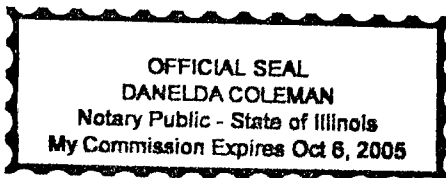
I, Mark Van Vleet, Vice President and General Counsel for Fender Musical Instruments Corporation, hereby declare that I have read the foregoing Petitioner's Answers to Respondent's First Set of Interrogatories, and state that to the best of my current knowledge, information, and belief, the facts stated therein are true and correct.

DATED: October 28, 2004


Mark Van Vleet

SWORN TO BEFORE ME this
28th day of October, 2004


NOTARY PUBLIC

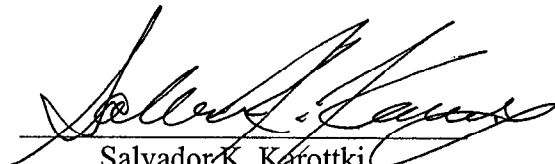


CERTIFICATE OF SERVICE

I, Salvador K. Karottki, an attorney, hereby certify that I caused **Petitioner's**
Answers to Respondent's First Set of Interrogatories to be served upon:

Lloyd A. Prins
San Dimas Guitar Company
2323 Via Saldivar
Glendale, California 91208

by causing a copy of same to be sent via Federal Express (overnight courier) on October 28,
2004.


Salvador K. Karottki

RECEIVED

NOV 15 2004

Lloyd A. Prins
San Dimas Guitar Company
2323 Via Saldivar
Glendale, CA 91208

November 13, 2004

Mr. Salvador K. Karottki
Goldberg, Kohn
55 East Monroe Street, Suite 3700
Chicago, IL 60603

Re: Petitioner's Answers to Registrant's Request for Discovery
Cancellation No. 92042614

Dear Mr. Karottki,

This letter is in response to the discovery responses served by your client Jackson/Charvel Manufacturing, Inc., on November 28, 2004. I find these responses incomplete and request that complete responses be served on or before Friday, November 19, 2004. Should I fail to receive complete responses at that time, I shall file a motion to compel discovery. This letter will serve to satisfy the requirements that the parties "meet and confer" about discovery disputes before filing a motion to compel discovery to the United States trademark Trial and Appeal Board ("TTAB").

In response to your general objections, let me first stress that no information subject to the attorney-client privilege is sought.

Regarding your general objection that my interrogatories and discovery requests seek competitively sensitive information or information of a confidential nature, I am willing to enter into a standard TTAB protective order for the protection of your confidential information. In this regard, please find enclosed a protective order for your client's signature. I look forward to receiving confirmation that this document has been filed with the TTAB.

Regarding your general objection that my use of the term "Petitioner" or "Petitioner's" is vague, ambiguous, and undefined in that it does not include predecessors-in-interest, I disagree with your attempt to modify your Petition for Cancellation by naming Akai and IMC as Joint Petitioners. I recognize that previous owners of Jackson/Charvel may be predecessors-in-interest, however assignment of that term to Akai, IMC or any other entity relies on facts not in evidence. Additionally, a person, company or entity whose status is "predecessor-in-interest" does not in of itself qualify this person, company or entity as a Joint Petitioner.

I also stress that I have made no discovery requests that are contrary to any provision of the Federal Rules of Civil Procedure. All requests are for information within the scope of permissible discovery, and no single request is unreasonably duplicative of other discovery sought. Annoyance or oppression, if any, caused by these discovery requests will not be unwarranted nor will the burden and expense be undue given the importance of the information sought. These requests are "reasonably calculated to lead to the discovery of admissible information" and are relevant to the claims and defenses in this dispute, as outlined below. See *Fed. R. Civ. Proc. 26(b)(1)*.

The discovery requests that I have made are sufficiently described so as to be deemed "reasonable". Requests are not barred for being overly broad when the circumstances dictate that the requests be framed broadly. See *Data-Link Sys., Inc. v. Data Line Serv. Co.*, 148 F.R.D. 225, 228 (N.D. Ill. 1992). The lack of public available information regarding the claims made in Jackson/Charvel's Petition for Cancellation necessitates that discovery be broad so that the dispute may be speedily resolved. Therefore, any burden imposed by these requests is outweighed by the likelihood that the information sought will lead to the discovery of admissible evidence, and that requests are not unduly burdensome in light of the needs of the case and the amount in controversy.

Referring to the instructions and definitions that I made a part of Registrant's First Interrogatories to Petitioner, specific and detailed requests were made upon Petitioner to attach as exhibits "all documents which have been prepared in connection with this proceeding or upon which Petitioner may rely or expect testimony to rely or such other documents as may be requested" and "For each answer to an Interrogatory, identify each and every document and tangible thing used in the preparation of that answer". In response to the twenty (20) interrogatories, Petitioner completely ignored this request and provided no documents in support of its replies. My request for documents and tangible things is supported by, and within the scope of the rules that govern this proceeding (see, *Fed. R. Civ. Proc. 26(a)(1)(B)(C)* and *26(b)(1), (3) and (5)*; C.F.R. 37 §2.120; and TTAB §402.01). Accordingly, Petitioner's full and strict compliance with these instructions and requests is warranted.

The legal bases for each discovery request follow. This is not an exhaustive list, but should serve to inform you of legitimacy of my discovery efforts.

Your Response to Interrogatory No.1

This interrogatory seeks to discover information regarding individuals who Petitioner may call upon to offer expert testimony in support of their pleadings. See *Fed. R. Civ. Proc. 26(a)(2)*. The fact that Petitioner's may elect not to call upon such expert testimony does not prevent Petitioner from disclosing the identity of individuals, companies or entities that may offer expert testimony. Registrant believes that this disclosure is likely to lead to admissible evidence and therefore warrants a thorough response.

Your Response to Interrogatory Nos. 2, 3, 11

These interrogatories seek to discover information regarding individuals who Petitioner may call upon to offer factual testimony in support of their pleadings. The response offered by Petitioner falls short in that the instructions that accompanied these interrogatories requested detailed information that was omitted in Petitioner's response. For example, Petitioner has provided no mention of job title, contact information, or where appropriate, last known whereabouts. The information sought in these interrogatories is within the scope and provision of the Federal Rules of Civil Procedure (see *Fed. R. Civ. Proc. 26(a)(1) and (3)*) and warrant thorough and comprehensive answers.

Your Response to Interrogatory Nos. 4, 8

These interrogatories seek to discover documents and tangible things that Petitioner claims support the facts in its pleadings. Referencing the opening paragraph numbers 5 and 6, these requests, although potentially lengthy in their reply, are within the scope and provisions of discovery (see *Fed. R. Civ. Proc. 26(b)(1)*) and any burden imposed by these requests are outweighed by the likelihood that the information sought will lead to the discovery of admissible evidence.

Your Response to Interrogatory Nos. 5, 6, 18

These interrogatories seek detailed information regarding Petitioner's conduct to obtain information related to Registrant's activities associated with Registrant's San Dimas mark.

These discovery requests do not seek to obtain information that is protected by attorney-client or attorney work product privileges. Registrant respects these doctrines and explicitly excludes such information in its requests.

Regarding Petitioner's specific objection that the term "investigation" is vague, and undefined, Petitioner merely needs to reference a commonly used dictionary for guidance. For such an objection to stand, one could conclude that every word used in a discovery request be either specifically defined or captured under a general definition statement. Additionally, Petitioner's objection is counter-productive to the discovery process and sets up an endless cycle of objections and counter-objections while word meanings are debated.

Interrogatory No. 6 seeks to discover information specific to the Petitioner's activities to track, study, search, collect, or interview for (collectively and commonly referred to as "investigate") information where the Registrant was the focus of such activities. This interrogatory is neither vague in its request, nor is it outside the scope and provisions of the Federal Rules of Civil Procedures.

Lastly, Interrogatories Nos. 5, 6 and 18 seek information regarding when and under what circumstances Petitioner first became aware of Registrant's mark. This information is relevant to both the likelihood of confusion between the Petitioner's alleged mark and Registrant's mark (as pleaded by Petitioner), as well as a determination of good faith on the part of the Petitioner in its Petition for Cancellation. As such, Interrogatories Nos. 5, 6 and 18 are proper and warrants complete and thorough responses.

Your Response to Interrogatory No. 9

This interrogatory seeks information pertaining to the facts, circumstances and specific terms of Petitioner's purchase of Jackson/Charvel from Akai. In its Petition for Cancellation, Petitioner alleges that it purchased all trademarks and intellectual property including the San Dimas trademark. This claim has not been supported by any testimony or documentary evidence. Furthermore, Interrogatory No. 9 seeks information that may indicate a potential dispute of ownership of Petitioner's alleged trademarks. If Petitioner does not own the trademarks claimed in the Petition for Cancellation, or acquired them improperly, this is certainly information crucial to the current dispute.

Your Response to Interrogatory No. 10

In response to Petitioner's objection that Interrogatory No. 10 assumes facts not in evidence in that "it assumes a 'date of last use'", Petitioner errors in interpreting this as applying only to marks no longer in use. Trademarks currently in use (i.e. those not terminated) could have a date of last use of "today".

Petitioner alleges in its Petition for Cancellation that it purchased various trademarks including the San Dimas trademark. A detailed listing of these trademarks and the circumstances surrounding the use and/or non-use of these trademarks is likely to lead to admissible evidence.

Interrogatory No. 10 also seeks information that characterizes the practices by which Petitioner obtains and maintains trademark protections and rights claimed in its Petition for Cancellation.

Given the reasons stated above, Registrant believes that a thorough and complete answer to Interrogatory No. 10 will likely lead to admissible evidence.

Your Response to Interrogatory No. 12

This interrogatory seeks information specific to the date of first use of Petitioner's San Dimas mark. This is relevant to establishing Petitioner's claim that Petitioner's alleged mark is senior to and has priority over Registrant's mark.

Interrogatory No. 12, parts A through I request that the Petitioner delineate the facts and circumstances that resulted in the launch of a newly trademarked product in June of 1993 (i.e. Petitioner's San Dimas mark).

Additionally, Registrant's requests for product serial numbers, dates of manufacturing and workorder numbers are relevant in that this information will likely lead to admissible evidence relative to the strength of Petitioner's mark. Registrant will accept disclosure of representative samples for each year 1993 through 2002 on the condition and stipulation that if requested, a full listing is made available to Registrant for inspection at a later date.

Lastly, Registrant's request that Petitioner identify the person or persons credited with originating Petitioner's San Dimas trademark concept (a concept that allegedly has resulted in the "sale of tens of hundreds of thousand of dollars worth" of product). This request is clear and unambiguous. It is relevant in that it seeks to identify an individual or individuals who may offer testimony key to these proceedings and will likely lead to admissible evidence.

Given the reasons stated above, a thorough and complete answer to this interrogatory is warranted.

Your Response to Interrogatory No. 13

This interrogatory asks Petitioner to describe in detail the differences, if any, that exist between Petitioner's products that carry the San Dimas trademark and Petitioner's products that do not carry the San Dimas trademark. This request is neither vague nor ambiguous. If Petitioner alleges that each and every electric guitar manufactured for sale by Petitioner carries the San Dimas trademark, then state as such. If Petitioner alleges that only some of electric guitar manufactured by Petitioner carry the San Dimas trademark, Registrant propounds Petitioner to delineate in detail the method by which Petitioner used the San Dimas mark to distinguish Petitioner's San Dimas trademarked products from Petitioner's non San Dimas trademarked products. A thorough and complete answer to this interrogatory is warranted in that it seeks to produce evidence that Petitioner's use of the term "San Dimas" constitutes a trademark (*See §45 (15 U.S.C. §1127)*) and if so, produce evidence that supports Petitioner's claims in its Petition for Cancellation.

Your Response to Interrogatories Nos. 14, 15

These interrogatories seek to discover information that supports Petitioner's claim of the financial contribution that comes to Petitioner through the use of Petitioner's San Dimas mark. They also seek to discover the strength of Petitioner's San Dimas mark to identify and distinguish its goods from other goods and as a source identifier. They also seek to discover if and/or how Petitioner will be damaged by Registrant's use of the San Dimas trademark. These requests are neither overly broad nor irrelevant in that thorough and complete responses are likely to result in admissible evidence. As stated in opening

paragraph 3, Registrant is willing to enter into a standard TTAB protective order for the protection of Petitioner's confidential information.

Your Response to Interrogatory No. 16

This interrogatory seeks information regarding the facts and legal arguments upon which Petitioner bases the allegations and pleadings contained in each and every paragraph numbers 1 through 12 of its Petition for Cancellation. These facts and arguments are the central issues of this proceeding and therefore warrant a thorough and comprehensive reply. General objections raised are address in opening paragraphs 2-6.

Your Response to Interrogatory No. 17

Similar to Interrogatory No. 12, this interrogatory seeks to understand how Petitioner made use of the San Dimas trademark on specific products built in 1995 and 1996 so as to evaluate this use against the standards set forth in 37 C.F.R. §45 (15 U.S.C. §1127). This request also seeks to understand the strength of Petitioners San Dimas mark, the mark's effectiveness to identify and distinguish its goods from other goods, and the mark's ability to serve as a source identifier.

Jackson/Charvel has provided Registrant with photocopies of a 1995 and a 1996 Charvel Guitar catalog that Petitioner claims to establish Petitioner's use of the San Dimas trademark. Registrant's reference to these publications is not for the purpose of entering facts not yet in evidence, but rather to aid Petitioner in identifying the products and time period referenced in this interrogatory. Absent catalogs beyond the year 1996, the inference exists that Petitioner ceased the production of these products.

The discovery sought in Interrogatory No. 17 is clear and unambiguous and if answered thoroughly would resolve any disputes in the accuracy of the facts. For this reason, full disclosure to this interrogatory is warranted.

Your Response to Interrogatory No. 19

In its Petition for Cancellation, Petitioner claims continuous use of the San Dimas trademark since 1993. Because Petitioner's introduction of the 25th Anniversary Charvel pre-dates Petitioner's cancellation filing by three months, and because Petitioner affixed the words "San Dimas" to this product, the facts and circumstances related to this product launch are relevant to this proceeding. Accordingly, Interrogatory No. 19 seeks information regarding when and under what circumstances Petitioner introduced the 25th Anniversary Charvel guitar. Because this information is not available through public means, Registrant must rely on Petitioner to provide the facts and circumstances sought in this discovery request. This information is relevant, as it is likely to lead to admissible evidence in determining, among other things, good faith on the part of the Petitioner in its introduction of this product. For these reasons, Interrogatory No. 19 warrants a thorough and comprehensive reply.

Your Response to Interrogatory No. 20

Interrogatory No. 20 is neither vague, unambiguous nor confusing in that it merely seeks to understand the facts upon which Petitioner relies in its answers to Registrant's requests for admissions. If Petitioner is able to deny an admission, Petitioner must be able to state facts on which such denial based. Registrant firmly believes that facts derived from this interrogatory will lead to admissible evidence and further believes that a thorough and comprehensive reply is warranted.

Your Response to Request for Production of Documents Nos. 1-18

Petitioner has objected to each and every request for the production of documents. In the few occurrences where documents were offered, Petitioner qualifies these occurrences with additional objections and restrictions. Petitioner's position with respect to its responds to the Registrant's request for production of documents is counter-productive to the discovery process. The basis for each and every document request made by Registrant is clear, unambiguous and within the scope of the rules that govern this proceeding. Registrant believes that Requests for Production of Documents numbers 1-18 will likely lead to admissible evidence and therefore warrants Petitioner's full and complete compliance with these requests.

Notwithstanding Petitioner's numerous objections, in the few occurrences where Petitioner has disclosed anything of substance, the information offered are overly generalized statements and fall short of the detailed information sought. Registrant emphasizes that what has been requested are merely the factual bases for Petitioner's own pleadings and allegations. As enumerated by the Petition for Cancellation, these are the central issues of this dispute. Thus it is inconsistent to claim, as Petitioner has, that the facts upon which these allegations are based are not relevant to the claims or defenses on file in this proceeding, nor admissible, nor reasonably calculated to lead to the discovery of admissible evidence. On the contrary, nothing could be more relevant to this dispute. Accordingly, these discovery requests are proper and responses to each are warranted.

Thank you for your time and attention.

Sincerely,



Lloyd A. Prins

Certificate of Mailing (37 C.F.R. 1.10)

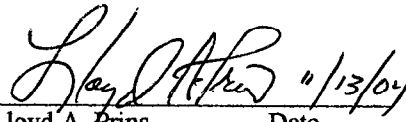
Notice of Service

I, Lloyd A. Prins certify that an original copy of:

Registrant's November 13, 2004 Letter regarding "Petitioner's Answers to Registrant's Request for Discovery" was mailed to the Petitioner on November 13, 2004 via USPS Express Overnight, article

number ED 3282 24165 US. This item was deposited with sufficient postage on November 13, 2004 and addressed to:

Mr. Salvador K. Karottki
Goldberg Kohn
55 East Monroe Street
Suite 3700
Chicago, IL 60603-5802


Lloyd A. Prins Date

Karottki, Salvador K.

From: Lloyd Prins [lprins@sandimasguitars.com]
Sent: Saturday, November 13, 2004 2:05 PM
To: Karottki, Salvador K.
Subject: San Dimas Guitars
Importance: High

Dear Mr. Karottki,

Thank you for mailings of October 28, 2004 and for your invitation to contact you if I have any further questions.

Today I place in the USPS Express Overnight Mail a request for your client, Jackson/Charvel, to provide more complete responses to my discovery requests. The post office assures me that your office will receive this package by 3:00 p.m. Monday.

Because my request is time sensitive, I thought it might be helpful to you and your client if you had an advanced copy of this mailing and in electronic format. For this reason, please find the attached file in MS Word format. This file is an exact copy of what I placed in the mail to you today.

If you have any questions regarding this request, please do not hesitate to contact me.

Sincerely,

Lloyd A. Prins
San Dimas Guitar Company
909-241-7997

12/27/2004

RECEIVED

NOV 17 2004

Lloyd A. Prins
San Dimas Guitar Company
2323 Via Saldivar
Glendale, CA 91208
(909) 241-7997

November 16, 2004

Mr. Salvador K. Karottki
Goldberg, Kohn
55 East Monroe Street, Suite 3700
Chicago, IL 60603

Re: Proposed Stipulation and Protective Order regarding Confidential Information
Cancellation No. 92042614

Dear Mr. Karottki,

I am sending to you today an original signed copy of the proposed Protective Order that I cited in my November 13, 2004 correspondence to you. If by chance this item inadvertently omitted, please find another signed copy enclosed. I am also enclosing a CD-ROM that contains this document in MS Word format.

Thank you for your attention to this matter. Please feel free to contact me if you have any questions or need additional information.

Kindest regards,



Lloyd Prins

Enclosures:
Stipulation and Protective Order
Exhibit A – Affidavit
CD-ROM

Karottki, Salvador K.

From: Karottki, Salvador K.
Sent: Wednesday, November 17, 2004 4:37 PM
To: 'Lloyd Prins'
Subject: Jackson/Charvel Manufacturing, Inc. v. Lloyd A. Prins

Dear Mr. Prins:

This e-mail is to confirm that I received your Rule 37 letter on Monday and your draft Confidentiality Stipulation and Protective Order today. We are reviewing your Rule 37 letter and will respond in writing. I have not yet had a chance to review your draft Protective Order, but I will do so and get back to you if we have any language changes. In the meantime, feel free to give me a call if you have any questions or would like to discuss these issues.

Very truly yours,

Salvador K. Karottki, Esq.
Goldberg, Kohn, Bell, Black, Rosenbloom & Moritz, Ltd.
55 East Monroe Street, Suite 3700
Chicago, IL 60603-5802
Phone: (312) 201-3861
Fax: (312) 863-7861
www.goldbergkohn.com

The information transmitted in this e-mail message and attachments, if any, may be attorney-client information, including privileged and confidential matter, and is intended only for the use of the individual or entity named above. Distribution to, or review by, unauthorized persons is prohibited. All personal messages express views solely of the sender, which are not to be attributed to Goldberg, Kohn, Bell, Black, Rosenbloom & Moritz, Ltd. If you have received this transmission in error, immediately notify us and permanently delete this transmission including attachments, if any.

12/27/2004

Karottki, Salvador K.

From: Karottki, Salvador K.
Sent: Monday, December 06, 2004 1:46 PM
To: 'Lloyd Prins'
Subject: Jackson/Charvel v. Sand Dimas Guitar Company

Dear Mr. Prins:

Attached please find the MS Word files you requested as a courtesy. Before I could send them to you, our IT staff had to remove any meta-data; therefore, sending these to you wasn't as easy as I initially thought. As you said on our call, I believe these come to late to be useful to you. However, having gone through the process of "cleaning" an MS Word document once, I can forward any pleadings to you in the future in need be.

I called you a couple of times last week at 909-241-7997 and was unable to reach you. Please give me a call today or tomorrow to discuss the Protective Order, as I would like to put this issue to bed so we can send you additional documents. Furthermore, we will get you additional information, as well as specific responses to your objections, this week. I look forward to speaking with you.

Best regards,

Salvador K. Karottki, Esq.
Goldberg, Kohn, Bell, Black, Rosenbloom & Moritz, Ltd.
55 East Monroe Street, Suite 3700
Chicago, IL 60603-5802
Phone: (312) 201-3861
Fax: (312) 863-7861
www.goldbergkohn.com

The information transmitted in this e-mail message and attachments, if any, may be attorney-client information, including privileged and confidential matter, and is intended only for the use of the individual or entity named above. Distribution to, or review by, unauthorized persons is prohibited. All personal messages express views solely of the sender, which are not to be attributed to Goldberg, Kohn, Bell, Black, Rosenbloom & Moritz, Ltd. If you have received this transmission in error, immediately notify us and permanently delete this transmission including attachments, if any.

-----Original Message-----

From: Lloyd Prins [mailto:lprins@sandimasguitars.com]
Sent: Tuesday, November 23, 2004 5:02 PM
To: Karottki, Salvador K.
Subject: Your call today

Dear Mr. Karottki,

Thank you for your call today and for updating me on the status of your client's reply to my correspondence of last week.

Thank you also for your offer to provide me with copies in MS Word format of your client's responses to my first requests for discovery and also your client's first discovery requests of me. I'd like to take you up on this generous offer. If you could, please have your assistant forward them to me as an email attachment to my email address at lprins@sandimasguitars.com.

If you have any questions concerning this request or any other matter we've discussed, please do not hesitate to call.

12/27/2004

Kindest regards,

Lloyd Prins

12/27/2004

December 27, 2004

sal.karottki@goldbergkohn.com
direct phone: 312.201.3861
direct fax: 312.863.7861

VIA FEDERAL EXPRESS AND ELECTRONIC MAIL

Lloyd A. Prins
San Dimas Guitar Company
2323 Via Saldivar
Glendale, California 91208

Re: *Jackson/Charvel Manufacturing, Inc. v. Prins*, Cancellation No. 92042614 – Response to Requests for Additional Answers to Discovery

Dear Mr. Prins:

This letter responds to your lengthy letter dated November 13, 2004. In that letter, among other things, you make extremely general arguments that the information you seek in your Interrogatory Requests to Jackson/Charvel Manufacturing, Inc. ("Jackson/Charvel") is relevant and reasonable. You then purport to provide arguments for why you believe Jackson/Charvel's responses are inadequate. In most cases, however, your arguments are unpersuasive, as Jackson/Charvel has provided adequate responses to your discovery requests, which generally seek information irrelevant to this Cancellation Proceeding. In the few cases where your arguments appear to have merit, Jackson/Charvel has seasonably supplemented its discovery responses. We will endeavor below to respond to each point you make in your November 13th letter.

Competitively Sensitive or Confidential Information

In your November 13th letter, you acknowledge Jackson/Charvel's concern about divulging confidential information about its business and business operations to you, a direct competitor. Indeed, in your own discovery responses, you objected to five (5) of Jackson/Charvel's interrogatory requests and six (6) of Jackson/Charvel's document requests on the identical ground that such requests sought confidential and proprietary information, and you provided no information to Jackson/Charvel. Given that both parties are concerned about this issue, it is our hope that we can reach agreement concerning a proper Confidentiality Agreement and Protective Order.

You indicate in your letter that you are willing to enter into a Protective Order and provided me with what appears to be a form agreement from the U.S. Patent and Trademark Office website. There are several items in this form agreement that either do not apply, since you are representing yourself *pro se*, or need to be modified because your company directly competes with Jackson/Charvel. I previously provided you with a revised Confidentiality Agreement and Protective Order ("Confidentiality Stipulation"). As noted in my prior correspondence to you, we have documents and information responsive to your discovery

Lloyd A. Prins
December 27, 2004
Page 2

requests that will be sent to you immediately if you sign this Confidentiality Stipulation. Please contact me as soon as possible to discuss the Confidentiality Stipulation and whether you agree to its terms.

Definition of "Petitioner" Includes Predecessors-in-Interest

In Jackson/Charvel's responses to your Interrogatory Requests, we clarified that the definition of "Petitioner" or "Petitioner's," which was not defined by you, includes Jackson/Charvel's predecessors-in-interest, including Akai Musical Instruments Corporation ("Akai") and International Music Company ("IMC"). Because Jackson/Charvel did not purchase the rights to the SAN DIMAS trademark until October 2002, all questions relating to use of the SAN DIMAS trademark prior to this date and the first use of the SAN DIMAS mark concern Jackson/Charvel's predecessors-in-interest. Without this clarification, your Interrogatory Requests make little sense and would seek a more limited pool of information. We made the clarification in order to properly answer your Interrogatory Requests and to properly describe the business reality concerning use of the SAN DIMAS trademark over time. Your objection that our clarification "relies on facts not in evidence" has no merit and, frankly, does not make any sense. Accordingly, your objection does not require a response.

You also erroneously conclude that Jackson/Charvel has somehow tried to amend its Petition for Cancellation to add Akai and IMC as parties by clarifying that the definition of "Petitioner" or "Petitioner's" includes predecessors-in-interest. You are mistaken, and Jackson/Charvel has not tried to add additional parties to this proceeding.

Interrogatories Requesting Production of Documents

On page 2 of your letter, you refer to the instruction section of your Interrogatory Requests, in which you request that Jackson/Charvel attach as exhibits "all documents which have been prepared in connection with this proceeding or upon which Petitioner may rely or expect testimony to rely or such other documents as may be requested." You state in your letter, "Petitioner completely ignored this request and provided no documents"

We did not ignore your requests that Jackson/Charvel produce documents in response to your Interrogatory Requests. Rather, we specifically objected to them, stating:

Jackson/Charvel objects to Prins' Interrogatories to the extent that they request the attachment of documents. Jackson/Charvel has contemporaneously responded to Document Requests served by Prins and objects to any additional requirement for . . . attaching documents to these Interrogatories

(Jackson/Charvel's Responses to Interrogatory Requests [hereinafter "Responses"] at 3.) Jackson/Charvel's objection is well taken. As you should be aware, the Trademark Trial and Appeal Board ("TTAB") has

Lloyd A. Prins
December 27, 2004
Page 3

held, "It is well settled . . . that Rule 33 [of the Federal Rules of Civil Procedure] is not the proper vehicle for the production of documents, but rather Rule 34 . . . must be utilized." *Varian Associates v. Fairfield-Noble Corporation*, 188 U.S.P.Q. 581, 584 (T.T.A.B. 1975). You served Document Requests pursuant to Rule 34 on Jackson/Charvel, and we have responded with objections and by producing documents. Accordingly, per the TTAB's precedent, it is improper for you to use your Interrogatory Requests as a device to require that Jackson/Charvel produce documents. Although Jackson/Charvel objected to your improper attempt to use Rule 33 to obtain documents, no response was or is necessary. Your arguments to the contrary have no merit.

Interrogatory No. 1

You sought information concerning any person that "may offer expert testimony in the above captioned proceeding." Jackson/Charvel has not determined whether it will offer expert testimony; therefore, no information could be provided. Jackson/Charvel has not designated a testifying expert.

Interrogatory Nos. 2, 3, 11

You state in your letter that these interrogatories "seek to discover information regarding individuals who Petitioner may call upon to offer factual testimony in support of [its] pleadings." To the extent that is true, no answer to these interrogatories is required. See, e.g., *Milliken & Co. v. Image Industries Inc.*, 39 U.S.F.Q.2d 1192, 1197 (T.T.A.B. 1996) ("[T]he Board does not require that a party respond to a discovery request asking for the identification of person it plans to call as witnesses . . ."); *Charrette Corp. v. Bowater Communication Papers Inc.*, 13 U.S.P.Q.2d 2040, 2041 (T.T.A.B. 1989) ("The Board has held that a party need not specify the evidence it intends to present in support of its case nor the identification of its witnesses." (citations omitted)).

In an attempt to cooperate in discovery, we provided detailed information concerning the names of Jackson/Charvel employees and former employees so that you could depose them if you deemed it necessary. You apparently find fault with Jackson/Charvel's responses because job titles were not listed after individuals' names and because addresses of current Jackson/Charvel employees were not provided, despite the fact that such employees are all reachable through counsel. We have supplemented Interrogatory No. 3 with additional information about facts of which individuals may be aware. (As noted above, you are not even entitled to an answer to your interrogatories.) We do not know the contact information for the former employees listed, although we continue to seek that information and will provide it if we learn additional information. Furthermore, all current employees of Jackson/Charvel can be reached through counsel; therefore, learning the addresses of current Jackson/Charvel employees has no value to you and appears to be only an attempt to intimidate those employees.

Lloyd A. Prins
 December 27, 2004
 Page 4

Your Interrogatory No. 11 requests information about marks other than Jackson/Charvel's SAN DIMAS trademark. As noted in Jackson/Charvel's objection, this information is ("not reasonably calculated to lead to the discovery of admissible evidence"); the information relates neither to your registered mark nor to the relevant mark used by Jackson/Charvel; SAN DIMAS. Jackson/Charvel's objection to your Interrogatory No. 11—that information concerning use of other marks is irrelevant—is supported by TTAB precedent. See, e.g., *Varian Associates*, 188 U.S.P.Q. at 584 ("Applicant has asked opposer to list all marks other than 'PALO ALTO' used by opposed. Such use is irrelevant to the issue of applicant's right to register its mark and opposer's claim of damage."); *American Optical Corp. v. Exomet, Inc.*, 181 U.S.P.Q. 120, 122 (T.T.A.B. 1974) (holding that "products that are not marketed in relation to or sold under the trademark 'SUPERGUARD'" can "have no possible relevance" to the proceeding), *overruled on other grounds by Johnson & Johnson v. Rexall Drug Co.*, 186 U.S.P.Q. 167 (T.T.A.B. 1975). Indeed, as you should be aware, the Trademark Trial and Appeal Board Manual of Procedure ("TBMP") specifically states: "A party need not provide discovery with respect to those of its marks and goods and/or services that are not involved in the proceeding and have no relevance thereto." TBMP § 414(11), at 400-70 (2d ed., 1st rev. 2004). You provide no arguments to the contrary; therefore, your position is without merit.

Interrogatory Nos. 4,8

Your Interrogatory No. 4 makes the overly broad request that Jackson/Charvel identify "each and every document and tangible thing that Petitioner claims support the facts and claims set forth in its Petition to Cancel." Obviously, all the documents produced in response to your Document Requests sent on October 28, 2004, fall into this category. The rest of Jackson/Charvel's responsive, non-privileged documents are confidential and will be provided to you once both parties sign the Confidentiality Stipulation that we sent you. These further documents also fall into the category outlined by Interrogatory No. 4. Rule 33(d) of the Federal Rules of Civil Procedure clearly allows a party to answer an interrogatory by producing business records. All of the documents that Jackson/Charvel produces potentially support or relate to Jackson/Charvel's claims, and any attempt to require Jackson/Charvel to list out these hundreds and hundreds of documents is unduly burdensome and oppressive. Furthermore, we see no reason why listing out the names of hundreds and hundreds of documents would be useful to you, other than to unnecessarily increase the costs of this proceeding.

Your Interrogatory No. 8 improperly requests a complete list of "all documents . . . that Petitioner intends to use in the preparation [sic] the above referenced proceeding." As noted above, "[t]he [TTAB] has held that a party need not specify the evidence it intends to present in support of its case" *Charrette Corp.*, 13 U.S.P.Q.2d at 2041; see also *Polaroid Corp. v. Opto Specs, Ltd.*, 181 U.S.P.Q. 542, 543 (T.T.A.B. 1974) ("[I]t has been frequently held that a party may not be required, by way of interrogatory, to specify in detail prior to trial the evidence which it expects to present in support of its case."), *overruled on other grounds by Johnson & Johnson v. Rexall Drug Co.*, 186 U.S.P.Q. 167 (T.T.A.B. 1975). Therefore, your Interrogatory No. 8 is objectionable, and your arguments to the contrary are without merit.

Lloyd A. Prins
December 27, 2004
Page 5

Interrogatory Nos. 5, 6, 18

You contend in your letter that "[t]hese interrogatories seek detailed information regarding Petitioner's conduct to obtain information related to Registrant's activities associated with Registrant's San Dimas mark." We do not understand how this information is relevant, but we have answered these interrogatories nonetheless.

Interrogatory No. 5 requests information concerning Jackson/Charvel's "efforts" to learn information about your use of the SAN DIMAS mark and your products. With respect to Interrogatory No. 5, Jackson/Charvel clearly answers:

[I]ts employees or agents reviewed Prins' website, as well as communications by and/or correspondence from Prins regarding his use of the SAN DIMAS mark. Jackson/Charvel's in-house counsel, Mark Van Vleet, also sent Prins correspondence concerning his infringing use of the SAN DIMAS mark

(Responses at Interrogatory No. 6.)

Interrogatory No. 6 requests information about "investigations" that Jackson/Charvel has conducted concerning you. In answering this interrogatory request, we referred to our answer to Interrogatory No. 5, and provided further information regarding correspondence between you and Jackson/Charvel's General Counsel. Jackson/Charvel has not conducted formal investigations into your infringing use of the SAN DIMAS mark. Again, this answer is complete as to your use of the SAN DIMAS mark. Furthermore, your Interrogatory No. 6 appears to contemplate a situation, such as in a toxic tort case, where investigators interview potential witnesses and make notes and reports. This has not occurred in this case. Again, we view further attempts to create a discovery dispute over this interrogatory answer to be harassment designed only to increase the costs associated with this proceeding.

Your Interrogatory No. 18, requesting information about the circumstances surrounding Jackson/Charvel's knowledge of your infringing use of the SAN DIMAS mark, is irrelevant. Despite this, we provided an answer. We believe this answer is sufficient. In the interest of cooperation, however, we will supplement our answer to Interrogatory No. 18 to provide additional detail.

Interrogatory No. 9

Your Interrogatory No. 9 seeks information concerning Jackson/Charvel's purchase of the SAN DIMAS mark from Akai in October 25, 2002. Jackson/Charvel answered this interrogatory request. You also improperly request information concerning the "purchase price" of all the assets Jackson/Charvel purchased from Akai, "a complete list of all assets purchased," "all trademarks purchased," and the total value of "good will included in the purchase." As noted above, information that relates to trademarks or

Lloyd A. Prins
December 27, 2004
Page 6

goods unrelated to the SAN DIMAS mark is irrelevant. *See, e.g., Varian Associates*, 188 U.S.P.Q. at 584; *American Optical Corp.*, 181 U.S.P.Q. at 122. Pursuant to Rule 33(d), we will provide, in redacted form, the Asset Purchase Agreement between Akai and Jackson/Charvel once both parties sign the Confidentiality Stipulation that we sent you.

Interrogatory No. 10

Your Interrogatory No. 10 improperly seeks information concerning all trademarks for which Jackson/Charvel claims ownership. As noted above, only the SAN DIMAS trademark is relevant. *See, e.g., Varian Associates*, 188 U.S.P.Q. at 584; *American Optical Corp.*, 181 U.S.P.Q. at 122. Jackson/Charvel fully answered this interrogatory request as to the SAN DIMAS trademark. To summarize here, Jackson/Charvel's predecessor-in-interest began using the SAN DIMAS trademark in 1993 in connection with guitars and/or basses. Jackson/Charvel is selling and has sold SAN DIMAS brand guitars in interstate commerce throughout the United States and in foreign countries. Jackson/Charvel continues to use the trademark SAN DIMAS.

You object to this answer because it does not provide a "date of last use." We reiterate our objection, that the phrase "date of last use" assumes facts not in evidence. Without waiving this objection, Jackson/Charvel states that it or its predecessor has never stopped using the SAN DIMAS trademark and that Jackson/Charvel continues to use the mark up to and through the date of this letter.

In your letter, you also state that Interrogatory No. 10 "seeks information that characterizes the practices by which Petitioner obtains and maintains trademark protections and rights claimed in its Petition for Cancellation." This language is found nowhere in Interrogatory No. 10. Your attempt to argue that such information was requested in Interrogatory No. 10 is disingenuous and unpersuasive.

Interrogatory No. 12

Your Interrogatory No. 12 requests a variety of information concerning use of the SAN DIMAS trademark. Jackson/Charvel provided you with an answer. I will summarize the information provided below:

- A) On or about June 22, 1993.
- B) (i) 4452 R. Airpark Drive, Ontario, California, 91761 and (ii) 311 Cessna Cir., Corona, California, 92880.
- C) An example point-of-sale display specimen was provided as JC 00039 in response to your Document Requests (requests for documents pursuant to Rule 33 are objectionable). Jackson/Charvel used and/or continues to use its SAN DIMAS mark,

Lloyd A. Prins
December 27, 2004
Page 7

inter alia, in advertising for its products, in catalogs, on materials associated with the products, and on point-of-sale displays for its products. In addition, both Jackson/Charvel sales staff and customers use the SAN DIMAS trademark as a source identifier for its products.

- D) See Answer to Interrogatory No. 3 and sub-part I below.
- E) Overbroad; Unduly burdensome; and Irrelevant. We will produce business records containing relevant information as soon as both parties sign the Confidentiality Stipulation.
- F) Overbroad; Unduly burdensome; and Irrelevant. We will produce business records containing relevant information as soon as both parties sign the Confidentiality Stipulation.
- G) Overbroad; Unduly burdensome; and Irrelevant. We will produce business records containing relevant information as soon as both parties sign the Confidentiality Stipulation.
- H) Jackson/Charvel sells SAN DIMAS brand guitars in interstate commerce throughout the United States and in foreign countries.
- I) Tommy Moore; Tommy Moore II; Todd Taliafaro; Mike Johnson; Steve Kaufman; and Tim Wilson.

As you will note, despite your argument to the contrary, Jackson/Charvel provided the approximate date of first use of the SAN DIMAS mark, as well as all of the other information requested, except each product's serial number, each product's date of manufacture, and each product's work order or production control number. We believe that your requests for each products' serial number, date of manufacture, work order, and production control number are unduly burdensome, overbroad, and irrelevant. We believe the TTAB will find them to be so as well. Despite the unduly burdensome nature of these requests, however, once both parties have signed the Confidentiality Stipulation, we will produce confidential business records, pursuant to Rule 33(d), that we believe provide responsive information.

Interrogatory No. 13

Your Interrogatory 13 requests information concerning the "method by which Petitioner used the San Dimas mark to distinguish products sold under this mark from Petitioner's non-San Dimas products . . . prior to October 2002." Jackson/Charvel answered this question. Frankly, your letter is incoherent with

Lloyd A. Prins
December 27, 2004
Page 8

regard to why you believe Jackson/Charvel's answer is inappropriate. As stated in Jackson/Charvel's answer (by reference to the answer to Interrogatory No. 12), Jackson/Charvel used its SAN DIMAS mark, *inter alia*, in advertising for its products, in catalogs, on materials associated with the products, and on point-of-sale displays for its products. In addition, both Jackson/Charvel sales staff and customers use the SAN DIMAS trademark as a source identifier for its products. The association of the SAN DIMAS mark with SAN DIMAS brand guitars distinguishes it from non-SAN DIMAS brand guitars. We do not understand why you believe Jackson/Charvel's answer is insufficient.

Interrogatory No. 14, 15

In your letter, you stated that "[t]hese interrogatories seek to discover information that supports Petitioner's claim of the financial contribution that comes to Petitioner through use of Petitioner's San Dimas mark." The TTAB has frequently recognized the confidential nature of a party's revenue figures. Once both parties sign the Confidentiality Stipulation, we will produce confidential business records that allow the determination of revenue figures associated with SAN DIMAS brand guitars. Revenue figures as to non-SAN DIMAS brand products are irrelevant.

Interrogatory No. 16

In your letter you erroneously state that your Interrogatory No. 16 "seeks information regarding *the facts* and legal arguments upon which Petitioner bases the allegations and pleadings contained *in each and every paragraph numbers 1 through 12 of its Petition for Cancellation*." A quick review of Interrogatory No. 16 shows no such language. In fact, Interrogatory No. 16 seeks only "the legal argument"—not factual basis—for Jackson/Charvel's "claim[ed] ownership and rights to exclusive use of the San Dimas mark."

Jackson/Charvel objected to this interrogatory request because it misconceives the entire basis of this Cancellation Proceeding. It is *your* claim of exclusive use and ownership of the SAN DIMAS mark, not Jackson/Charvel's, which is the subject of this proceeding. As outlined in Jackson/Charvel's answer to Interrogatory No. 16, the legal argument for why your registration for the mark SAN DIMAS should be cancelled is very clearly outlined in Jackson/Charvel's Petition for Cancellation.

We believe we have provided more than enough detail concerning Interrogatory No. 16, especially in light of your responses to Jackson/Charvel's interrogatory requests. For example, when Jackson/Charvel asked, *inter alia*, what the legal basis for your Second Affirmative Defense—waiver—was, you responded, "Petitioner waived any and all rights to a trademark that included the term San Dimas in whole or in part." You certified to the accuracy of your interrogatory answers; therefore, you apparently deemed this answer to Jackson/Charvel's interrogatory request to be sufficient and complete. Yet, when Jackson/Charvel provided a much more detailed legal basis for its claims than you did, you requested a more "thorough and

Lloyd A. Prins
December 27, 2004
Page 9

comprehensive reply" from Jackson/Charvel. We are sure that the TTAB will not appreciate such obvious "talking out of both sides of your mouth."

Interrogatory No. 17

In your letter, by referencing Interrogatory No. 12, you tacitly admit that Interrogatory No. 17 is duplicative of information already requested. Because of the duplicative nature of the interrogatory request, Jackson/Charvel referenced its prior answers to Interrogatory Nos. 12 and 13 in its answer to Interrogatory No. 17. Interrogatory 17 is at least the third interrogatory request where you ask how the SAN DIMAS trademark was "used in association with the sale of" SAN DIMAS brand guitars. Furthermore, Interrogatory No. 17 again asks for a "description of the specimen trademark" and the identity of "persons who originated [the] concept" of the San DIMAS trademark (same as Interrogatory No. 12). We do not understand why Jackson/Charvel's answer concerning the times and methods of sale of SAN DIMAS brand guitar products is unacceptable. Your letter provides no elucidation on this point.

Interrogatory No. 19

Interrogatory No. 19 is irrelevant. It concerns the details of a product launch—Jackson/Charvel's 25th Anniversary SAN DIMAS guitar—that occurred *after* your filing date for your SAN DIMAS trademark. Necessarily, this product launch has nothing to do with any rights that are prior to your filing date; yet, you still claim that "the facts and circumstances related to this product launch are relevant to this proceeding." They are not, and your arguments to the contrary are without merit.

We believe that you feel that Jackson/Charvel somehow learned of your trademark and, within a matter of weeks, launched a new product to somehow preempt your rights. While this argument makes no sense (in light of the fact that the product launch occurred after your filing date), we will nonetheless supplement our interrogatory answer in order to avoid a discovery battle over ultimately irrelevant information.

Interrogatory No. 20

We did not understand your Interrogatory No. 20 and believed that you were somehow trying to turn your Rule 33 interrogatory requests into Rule 26 requests for admission. Therefore, we objected to your Interrogatory No. 20. Upon review of your letter and the language of Interrogatory 20, we will supplement our answer to provide the basis for any of Jackson/Charvel's denials of requests to admit.

Document Requests

Jackson/Charvel responded to a majority of your document requests, sending you almost a hundred pages of documents. In addition, as noted above, Jackson/Charvel stands ready to provide you with its

Lloyd A. Prins
December 27, 2004
Page 10

confidential documents as soon as both parties sign a Confidentiality Stipulation. In contrast, you produced *four pages* of documents to Jackson/Charvel.

Jackson/Charvel produced documents to you despite the obviously irrelevant nature and, frankly, (we believe) harassing purpose of most of your requests. For example, you requested "all financial statements . . . furnished by Petitioner to any bank or lender;" "Petitioners' check register(s), bank statements, cancelled checks, and account records regarding deposits since 1993 for each depository at which Petitioner had any checking or savings account;" "copies of Petitioner's state and federal income tax returns . . . from 1993 through 2003;" "any artist agreement . . . relating to . . . any individual for their endorsement of Petitioner's products;" "any agreement [or] contracts . . . related to the acquisition of component parts;" "all employee rosters;" and "all consumer-completed product registration[s]." None of these improper document requests are limited to SAN DIMAS brand products. These requests have nothing to do with this case and constitute a blatant attempt on your part to learn competitively valuable trade secrets about Jackson/Charvel, its customers, its products, its employees, its parts suppliers, and the artists who endorse Jackson/Charvel's products.

While Jackson/Charvel will cooperate in producing relevant documents pursuant to a Confidentiality Stipulation, it will not subject itself to opening all of its financial reports and contracts to its direct competitor. We reject any argument made in your letter to the contrary.

Summary

In conclusion, we are supplementing our discovery responses concerning several of your Interrogatory Requests. However, on multiple occasions, we do so only to avoid needless bickering over irrelevancies, not because your requests are relevant or the arguments in your November 13th letter have merit. With respect to many of your Interrogatory Requests, however, no answer is required, as they seek information about other marks and products that have nothing to do with this proceeding or improperly request information about witnesses and documents that may be used at trial.

Lloyd A. Prins
December 27, 2004
Page 11

We hope that this letter and Jackson/Charvel's supplemental answers to your Interrogatory Requests will resolve any discovery dispute between you and Jackson/Charvel. Toward that end, we invite you to contact us if you have any questions concerning the contents of this letter. In addition, we request that you sign the Confidentiality Stipulation that we sent you, as we believe that many of your questions will be answered by reviewing certain confidential documents. We look forward to receiving the signed Confidentiality Stipulation and working with you informally to resolve any outstanding discovery requests without having to involve the TTAB.

Very truly yours,

A handwritten signature in dark ink, appearing to read "Salvador K. Karottki", written in a cursive style.

Salvador K. Karottki

cc: Oscar L. Alcantara

CERTIFICATE OF SERVICE

The undersigned, an attorney, hereby certifies that on December 27, 2004, he caused a true and correct copy of the foregoing **Petitioner's Response in Opposition to Registrant's Motion to Compel**, to be served by U.S. mail, postage pre-paid upon:

Lloyd A. Prins
San Dimas Guitar Company
2323 Via Saldivar
Glendale, California 91208



Salvador K. Karottka

TTAB

GOLDBERG KOHN

GOLDBERG KOHN BELL BLACK ROSENBLUM & MORITZ, LTD

December 27, 2004

sal.karottki@goldbergkohn.com

direct phone: 312.201.3861

direct fax: 312.863.7861

VIA EXPRESS MAIL NO. EL873830120US

BOX TTAB/NO FEE
UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Re: JACKSON/CHARVEL MANUFACTURING, INC. v. PRINS, LLOYD A.
CANCELLATION NO. 92042614

Dear Sir or Madam:

Please find enclosed the Petitioner's Response in Opposition to Registrant's Motion to Compel in connection with the above-referenced matter (Cancellation No. 92042614).

Please contact me if you have any questions or comments in this regard.

Best regards,



Salvador K. Karottki

SKK.ck

Enclosure

cc: Lloyd A. Prins



12-29-2004

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #66